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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,005	09/12/2000	Thomas E. Saulpaugh	5181-66200	6061

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ATTEN: ROBERT C. KOWERT
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EXAMINER

BENGZON, GREG C

ART UNIT	PAPER NUMBER
2144	

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/660,005

Applicant(s)

SAULPAUGH ET AL

Examiner

Greg Bengzon

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☒ Claim(s) 5-7, 18-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date 9/18/06
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This application has been examined. Claims 1-28 are pending.

Priority

This application claims benefits of priority from Provisional Application 60/202975 filed May 9, 2000.

This application claims priority to various provisional applications. The effective filing date for those claims which do not have proper support in their provisional application is 9/12/2000.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7, 12, and 25-28 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "computer executable code built in to said device" in Line 5-6 of the claim. It is unclear what this limitation is attempting to describe. This limitation fails to qualify how code is "built in" to a given device, and what

Art Unit: 2144

constitutes executable code being "built in" to an arbitrary device". There is no readily available interpretation which distinguishes or specifies what is being claimed, including pure hardware, pure stored software, hardware containing software (e.g., integrated/flashable circuit boards), the installation of software on existing hardware, the use of volatile or non-volatile memory storage, or any other embodiment which executes computational methodologies, rendering the claims) indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Art Unit: 2144

Claims 1-4,8-17,21-28 rejected under 35 U.S.C. 102(e) as being anticipated by Weschler (US Patent 6842903).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Weschler disclosed (re. Claim 1) receiving an address for a service (Weschler-Column 8 Lines 5-10) within the distributed computing environment ; linking said address to a pre-generated (Weschler-Column 4 Lines 15-30, Column 6 Lines 25-30 , 'factory' methods) message interface (Weschler-Column 6 Lines 20-25) for accessing said service, wherein said message interface comprises computer-executable code built in (Weschler-Column 6 Lines 55-60) to said device, wherein the pre-generated message interface is constructed prior to runtime, (Weschler-Column 4 Lines 15-30, Column 6 Lines 25-30 , 'factory' methods, 'service adapters') and wherein said linking creates a message endpoint (Weschler-Column 6 Lines 45-50) for said device to send messages to said service (Weschler-Column 6 Lines 60-65) at said address in order to access said service; using said message endpoint to send messages to said address to access said service.

Art Unit: 2144

Weschler disclosed (re. Claim 2) message endpoint verifying that said messages sent to said service comply with a message schema (Column 6 Lines 25-30) for said service.

Weschler disclosed (re. Claim 3,4) wherein said message schema defines messages to be sent to and received from said service, wherein said messages are defined in a data representation language. (Weschler-Column 6 Lines 60-65)

Claims 8-17,21-28 are rejected on the same basis as Claims 1-4.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-4,8-17,21-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roberts et al. (US Patent 6560633) hereinafter referred to as Roberts, in view of Chen et al. (US Publication 20020062334) hereinafter referred to as Chen.

Roberts disclosed message endpoint construction (inter alia, Column 4, Lines 30-31) in a distributed computing environment (inter alia, Column 2, Lines 35-43) where a pre-generated message interface was constructed prior to

Art Unit: 2144

runtime (Column 13 Lines 15-20, '*templates build the program prior to running*') to link a service address to a defined message endpoint directive (inter alia, Column 4, Lines 34-38). The message endpoint schema(s) were well known and defined within the boundaries of the XML specification. See, inter alia, Column 4, Lines 12-20. Roberts web service applications (WSA) provided access control and interface definitions to application services. See, inter alia, Column 4, Lines 34-38.

Further, Roberts disclosed run-time models (RTM) which served to define the process of the distributed application process. See, inter alia, Columns 7-8. Service calls were described to invoke application processes including reference to any corresponding WSA. See, inter alia, Column 9, Lines 1-8. The use of Java for WSA construction (Column 11, Lines 11-18) as well as XML based messaging (Column 16, Lines 20-24) were fully disclosed.

Lastly, since services were available on the network, and unique addressing/specification/designation of every service was inherent in order for the service to be called, and messaging was fully enabled using XML documents defining both incoming and outgoing format(s) for services, the linking of addresses) to a given pre-generated messaging interface was present. (Roberts-Column 13 Lines 35-40)

However, Roberts did not disclose (re. Claim 1) where the template is built-in to said device.

Chen disclosed (re. Claim 1) distributed dynamic agents to access to web services, wherein said agents are built-in APIs to the said device. (Paragraph 63)

Roberts and Chen are analogous art because they present concepts and practices regarding the use of pre-defined interfaces for web services. At the time of the invention it would have been obvious to combine Chen into Roberts. The motivation for said combination would have been, as Chen suggests (Abstract), to allow the pre-defined template by Roberts adjust its capability for accommodating environment and requirement changes.

Claim Objections

Claims 5-7 and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and additionally remedied to overcome issues raised under 35 U.S.C. 112, second paragraph.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 2144

The Applicant, via telephonic interview, presented the following citations in the Applicant Specifications regarding 'computer executable code built in to said device':

Page 13, Line 29 thru Page 14 Line 30

Page 31 Line 16 thru Page 32 Line 4

Page 43 Lines 2-18

Page 44 Lines 12 thru Page 46 Line 12

The USC 112 2nd paragraph rejection is maintained by the Examiner, as the Applicant did not sufficiently address the issues presented in the prior Office Action. The Examiner notes that citations presented above seem to indicate computer instructions [software features] that are included with the (Java) operating system installed on the device.

The Applicant presents the following argument(s) [*in italics*]:

Interfaces that are downloaded and used by a client application are clearly different from a pre-generated message interface that includes code built in to a device and that is constructed prior to runtime. The downloaded operation of Roberts relied on by the Examiner clearly occurs at runtime.

As presented above, Chen disclosed built-in APIs with predefined (Chen-Paragraph 32, Paragraph 39) dynamic agents.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to the PTO-892 form.

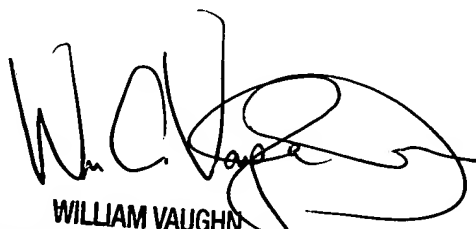
Art Unit: 2144

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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